

Application Serial No. 10/767,961

REMARKS**I. Record of Telephone Interviews**

On November 20, 2007, M. Scott Carey, of Flexplay Technologies, Inc., and the undersigned conducted a telephone interview with Examiner Davis. During the interview, we discussed the Examiner's rejections contained in the Office Action mailed on September 12, 2007.

With respect to the Examiner's rejection of Claims 7-34 and 37-61, Applicant proposed that these claims should not be rejected under In re Orita, 550 F.2d 1277, 193 U.S.P.Q. 145 (C.C.P.A. 1977). In re Orita holds that an applicant should not be permitted to claim previously "non-elected" embodiments in reissue prosecution. Applicant suggested the claims that ultimately issued in the original parent application and in the two divisional applications are related to several different embodiments beyond the two that were initially elected during the original prosecution (species IX, Figure 12 and sub-species III, Figure 3). Accordingly, Applicant asserted that Claims 7-34 and 37-59 in the current pending claim set are related to embodiments that were allowed and issued as claims from the original parent application and the two divisional applications. No agreement was reached with Examiner Davis during the telephone interview on November 20, 2007.

On December 13, 2007, M. Scott Carey and the undersigned conducted a second telephone interview with Examiner Davis. During the interview, we discussed pursuing generic claims linking multiple embodiments of the invention as permitted under In re Doyle, 293 F.3d 1355, 63 U.S.P.Q.2d 1161 (Fed. Cir. 2002) and as discussed in MPEP § 1412.01. Examiner Davis indicated that he would consider this position further and no agreement was reached during the telephone interview on December 13, 2007.

II. Office Action Mailed September 12, 2007

In the Office Action the Examiner indicated Claims 1-6 are allowable and rejected Claims 7-34 and 37-61. Applicant thanks the Examiner for the indication of allowable subject matter and for the careful review of this application. Upon entry of the claim amendments set forth above, Claims 1-6, 20, 21, 25, 33, 38-42, 59, and 60 remain pending in this application and the independent claims are Claims 1, 2, 59 and 60. Applicant has canceled Claims 7-19, 22-24, 26-32, 34-37, 43-58, and 61 without prejudice and Applicant respectfully traverses the Examiner's

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positions in the Office Action.

A. Statement Under 37 C.F.R. 3.73(b)

The Examiner states again in the present Office Action that “[t]he reissue oath/declaration filed with this application is defective (see 37 CFR 3.73(b)) because . . . Assignee failed to indicate the extent of ownership interest by either percentage or entire right.” Applicant submits that a corrected Statement Under 37 C.F.R. 3.73(b) indicating that Assignee owns the entire right, title, and interest in the application was filed on June 30, 2006. Applicant further submits that another Statement Under 37 C.F.R. 3.73(b) was filed with the Revocation of Power of Attorney with New Power of Attorney filed on May 18, 2007. Accordingly, Applicant submits that this defect has been fully addressed.

B. Rejection of Claims 7-34 and 37-61

The Examiner rejected Claims 7-34 and 37-61 as directed to subject matter that was “non-elected” in responding to the restriction requirements during prosecution of the original parent application and two divisional applications. The Examiner contends that:

Claims 7-17 belong to Sub-Species VI, figure 17, for example, which is directed to rendering the disk unreadable due to ambient air or moisture. Claims 18-34, and 37-59 belong, for example, to Species VI, VII and VII [sic] which is directed to rendering the disk unreadable due to ambient air or moisture or solvent.

Applicant respectfully traverses the Examiner’s species grouping of Claims 7-34 and 37-61 and the Examiner’s position that these claims are directed to subject matter that was “non-elected” during the original prosecution. Applicant reserves its right to dispute in the future the Examiner’s positions concerning the species grouping of the claims and that they are directed to “non-elected” subject matter. Nonetheless, in the interest of expediting prosecution, Applicant has canceled many of these claims, without prejudice, and asserts that the remaining claims are allowable under In re Doyle and MPEP § 1412.01.

MPEP § 1412.01 states that in In re Doyle “the court permitted the patentee to file a reissue application to present a so-called linking claim, a claim broad enough to read or link the invention elected (and patented) together with the invention not elected. The non-elected

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invention(s) were inadvertently not filed as a divisional application." While Applicant does not concede that the pending claims are "non-elected inventions," Applicant submits that the claims remaining in this application are linking claims permitted under MPEP § 1412.01. Specifically, Claim 59 reads upon at least the embodiments shown in Figures 3, 6, 7, 9 and 10. Claim 60 reads upon all of the inventive embodiments illustrated in the Figures. The requirement in In re Doyle with respect to linking claims does not apply to independent Claims 1 and 2 because Claims 1-6 were the originally allowed claims in U.S. Patent No. 6,343,063 on which this reissue application is based. Applicant submits that independent Claims 59 and 60 are linking claims permitted under MPEP § 1412.01 and, therefore, should be allowed.

CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed September 12, 2007. Applicant and the undersigned thank Examiner Davis for considering these remarks. If the Examiner believes that any issues exist that can be resolved by telephone conference, or that any formalities exist that can be corrected by an Examiner's Amendment, please contact the undersigned at (404) 572-3505.

Respectfully submitted,



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